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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,973

12/09/2003

William Y. Sun

2202

7590

11/02/2005

Clyde I. Coughenour  
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Woodbridge, VA 22191

EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TALH

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,973	<b>Applicant(s)</b> SUN, WILLIAM Y.	
	<b>Examiner</b> Beverly M. Flanagan	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

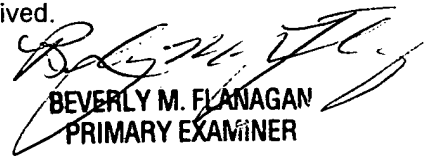
- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 3, 5 and 10-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
    - 1. ☐ Certified copies of the priority documents have been received.
    - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

  
**BEVERLY M. FLANAGAN**  
**PRIMARY EXAMINER**

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Previously Set Forth Rejections***

The 35 U.S.C. § 112, second paragraph, rejection of claims 5, 11 and 14 has been overcome. The 35 U.S.C. § 103(a) rejection of claims 1, 2, 4 and 6-9 as being unpatentable over Van Dam (U.S. Patent No. 5,065,738) in view of Rooney et al. (U.S. Patent No. 5,656,014) is hereby *maintained*. Claims 3,5 and 10-17 continue to be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**The following reiterated grounds of rejection are set forth:**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dam (U.S. Patent No. 5,065,738) and Rooney et al. (U.S. Patent No. 5,656,014).

**In regard to claims 1, 2 and 8**, Van Dam teaches a laryngoscope 10 having a blade 12 having a sheath 48 that has a top surface, a bottom surface, a forward end, a

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rear end, a first side, a second side and a central area as well as rounded edges and having surface pads 58 and 60 made of foam that attach to the blade 12 (see Figure 2 and 4 and col. 6, lines 54-62). The sheath 48 also has an adhesive surface 56 provided with a pressure sensitive adhesive 66 that is protected by a waxed film 68 for attaching the sheath 48 to the blade 12 (see Figure 2 and col. 6, lines 45-55). Van Dam is silent as to a tongue-engaging plate on the sheath 48. However, Rooney et al. disclose a similar device 10 having a curved forward end portion 16 provided with an abrasive texture 65 for gripping a patient's tongue (see Figure 5 and col. 3, lines 15-25). Rooney et al. thus demonstrate that devices having tongue-gripping textures for gripping and holding the tongue during an examination are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to supply the exterior surface of the sheath 48 of Van Dam with a texture, as disclosed by Rooney et al., for the purpose of gripping and holding the tongue. **In regard to claim 4**, Rooney et al. are silent as to the thickness of texture 65. However, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the texture in a thickness of 0.015 to 0.125 inches, so that the texture does not unduly interfere with the operation of the laryngoscope (e.g., it is not too thick). **In regard to claim 6**, Rooney et al. are silent as to the length of the texture 65. However, However, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the texture in a length of 1 to 2 ½ inches long, so that the texture does not unduly interfere with the operation of the laryngoscope (e.g., it does not encompass the entire length of the blade). Note also that Rooney et

al. show the texture 65 as being at the end of the device 10, not along the entire length (see Figure 5 of Rooney et al.). **In regard to claims 7 and 9**, see col. 6, lines 59-62 of Van Dam.

### ***Allowable Subject Matter***

Claims 3, 5 and 10-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed August 8, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the portions of the tongue depressor of Rooney et al. have nothing to do with the sheath, it is noted that Rooney et al. is relied upon as a teaching of a texture to grip and hold a tongue. Since Rooney et al. demonstrate that device having a texture to grip and hold a tongue are well known and advantageous in the art, it would have been obvious for one of ordinary skill in the art to apply the texture taught by Rooney et al. to the sheath 48 of Van Dam, for the purpose of better holding and gripping the tongue. Rooney et al. do not teach a sheath – the sheath that applicant refers to at page 3 of the arguments is a plate 48 that overlies a switch recess 44 (see Figure 3 of Rooney et al.). Furthermore, the plate 48 does not

come into contact with the texture 65 for gripping the tongue, which is positioned at the distal tip of the blade (see Figure 3 of Rooney et al).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as noted above, Rooney et al. teach using a texture to grip and hold the tongue that would not, as applied to the sheath of Van Dam, render the sheath inoperative.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, the argument that patents that only teach two layers secured together cannot logically or legally render obvious a claim to a patent claim teaching three layers is not well taken.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

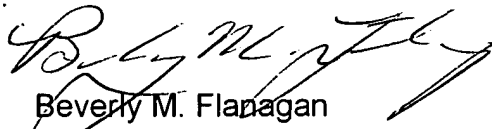
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Beverly M. Flanagan  
Primary Examiner  
Art Unit 3739

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